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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

501609

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on August 5, 2005Signature Nancy KlosterTyped or printed name Nancy Kloster

Application Number

09/996,295

Filed

November 28, 2001

First Named Inventor

James C. Manning

Art Unit

3729

Examiner

Rick Kiltae Chang

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒ attorney or agent of record. 35,110
Registration number☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

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Typed or printed name

(815) 484-1900

Telephone number

AUGUST 5, 2005
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT
Attorney Docket No. 501609
Client Reference No.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

James C. Manning

Art Unit: 3729

Application No.: 09/996,295

Examiner: Rick Kiltae Chang

Filed: November 28, 2001

For: WIRE INSTALLATION TOOL

ATTACHMENT TO PRE-APPEAL BRIEF REQUEST

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant respectfully requests pre-Appeal Brief Review of the issues enumerated below, to hopefully expedite allowance of the claims in the present patent application:

1. Whether the Examiner's assertion, at paragraph 11 of the Advisory Action mailed July 21, 2005, that the below-underlined limitations of Applicant's independent claim 13, from which all other claims under consideration depend, requiring "two or more rollers rotatably positioned adjacent the inner edge for precluding contact of a wire passing through the aperture with any portion of the inner edge of the aperture" constitutes "*nothing more than functional language*", which apparently the Examiner has excluded from examination of Applicant's claims on the merits.

Applicant believes that the functional limitation which the Examiner has ignored, must be evaluated and considered just like any other limitation of the

claim for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used, as stated in MPEP § 2173.05(g). Applicant believes that the language ignored by the Examiner, although functional, constitutes a perfectly acceptable claim limitation, because it sets definite boundaries on the patent protection sought by the Applicant, and serves to precisely define present structural attributes of inter-related component parts of the claimed assembly. (*See, MPEP § 2173.05(g)*, citing *In re Barr*, and *In re Venezia*).

Specifically, the functional limitation ignored by the Examiner precisely defines structural attributes of the rollers and aperture, of Applicant's invention, in a manner requiring that the rollers and aperture be configured and oriented with respect to one another within definite structural boundaries, so that the rollers perform in a manner which is critical to operation of the Applicant's invention, i.e. precluding contact of a wire or cable passing through the aperture of Applicant's device with any portion of the inner edge of the aperture, to thereby prevent any portion of the edge of the aperture from causing damage to the cable as it is pulled through the aperture.

The claim limitations which the Examiner has chosen to ignore, clearly distinguish the Applicant's invention over the prior art cited by the Examiner. (See Applicant's Remarks and sketch at pages 5, and 7-9, in Applicant's Response to Final Office Action and Request for Consideration filed July 6, 2005).

2. Whether the Examiner's rejection of the claim limitation referenced in paragraph 1 above as being "nothing more than functional language" constitutes new grounds for rejection, not previously presented by the Examiner, and not resulting from an Amendment by the Applicant, which should have occasioned withdrawal of the finality of the Office Action dated May 6, 2005, so that the Applicant could respond to these new grounds of rejection as a matter of right.

Applicant's Response to Final Office Action and Request for Reconsideration did not include any amendment to the claims under consideration

and subject to the Final Office Action of May 6, 2005. It appears that upon reviewing the Applicant's traversal of all rejections in the Final Office Action, as stated in Applicant's Response to the Final Office and Request for Reconsideration, the Examiner decided to, for the first time, raise the new grounds for rejection discussed in paragraph 1 above.

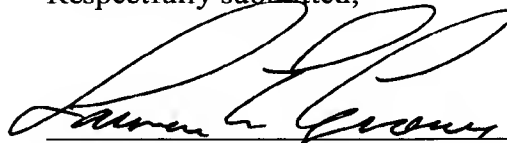
Formal Matters

Applicant does not seek to have addressed, as part of the pre-Appeal Brief Review, the Examiner's notation at paragraph 13 of the Advisory Action dated July 21, 2005, that "a complete listing of all of the claims is not present". Applicant agrees with the Examiner's observation that a complete listing of all claims was not provided in the Applicant's communication of July 6, 2005. Applicant notes that an entry in the claim listing, stating that claims 1-10 had been cancelled, was inadvertently omitted from the listing of claims. Applicant believes this to be a purely formal matter, which can be simply rectified subsequent to the requested pre-Appeal Brief Review.

Conclusion

Based on the foregoing, Applicant is hopeful that the rejections will be withdrawn and a Notice of Allowance is issued. Applicant's counsel would certainly welcome a telephonic interview with any of the three panel members conducting the pre-Appeal Brief Review, to advance prosecution and move the matter forward in the most efficient manner possible. Therefore, should any questions arise, please feel free to contact the undersigned attorney.

Respectfully submitted,



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Date: August 5, 2005